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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,669	02/06/2004	Steffen Dubnack	ZEI-3226/500343.20238	7534
20999 7590 07/19/2010 FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151				
EXAMINER				
EISEMAN, ADAM JARED				
ART UNIT		PAPER NUMBER		
3736				
MAIL DATE		DELIVERY MODE		
07/19/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/773,669

**Applicant(s)**

DUBNACK ET AL.

**Examiner**

ADAM J. EISEMAN

**Art Unit**

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 April 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This action is responsive to applicant's arguments/remarks filed on 4/28/2010.

***Claim Rejections - 35 USC § 103***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fizzell et al (US 2,704,064) in view of Kucharczyk et al (US 6,626,902).

Fizzell discloses a neurosurgical stimulator and method of use in tissue selective treatment in neurosurgery comprising the steps of:

- Placing a probe in an area of body tissue of a brain of a body of a person being treated (cranial nerve is part of the brain; column 1, lines 19-46)
- Stimulating the area of body tissue by causing the probe to send to the area different electrical and/or electromagnetic stimulus signals which can be preadjusted or modulated (column 4, lines 27-77)
- Identifying any pathologically changed tissue parts in the area of body tissue by identifying those tissue parts for which the person being treated provides no stimulus response or an unexpected stimulus response, wherein the response identified is a change to the body's functioning distinct from the properties of the body tissue being stimulated (column 1, lines 19-75)

- Treating the area of body tissue, wherein the treatment comprises selecting and removing any pathologically changed tissue parts (column 1, lines 35-45)
- Wherein if the tissue stimulation does not identify a pathologically changed tissue part, the probe is repositioned and a new area of body tissue is stimulated (column 1, lines 35-45)

However, Fizzell does not disclose that it is the probe that does the removal of the body tissue.

Kucharczyk teaches a multi-probe catheter system which has multiple lumens on a probe catheter which allows for multiple functions including applying electrical stimulus and tissue removal through the catheter probe (column 10, line 22 – column 11, line 26).

Regarding claims 1-3; it would have been obvious to one of ordinary skill in the art at the time of the invention to substitute Fizzell's probe for only stimulation with Kucharczyk's probe in order to allow for body stimulation and removal of tissue to be performed by a single probe and operation as taught by Kuicharczyk.

Further regarding claim 2; Fizzell discloses the signal as iterative or continuous (column 3, line 1 – column 5, line 46).

Further regarding claim 3; Fizzell discloses that during tissue stimulation is carried out by alternating treatment and positioning with tissue stimulation and immediate evaluation of stimulus responses (surgeon applies stimulation, evaluates if there is a reaction or no reaction, treats and repositions; column 1, lines 19-46); and

during treatment of critical tissue regions the treatment can be interrupted/stopped (column 5, lines 47 - column 6, line 3).

***Response to Arguments***

4. Applicant's arguments with respect to claims 1-3 have been considered but are moot in view of the new ground(s) of rejection.

The applicant argued that the previous prior art on record did not have motivation for combination and that it did not specifically disclose the removal of tissue. The examiner agrees with the applicant's arguments and has provided the new grounds of rejection presented above using the Fizzell and Kucharczyk references to make up for the deficiencies of the previous rejection.

***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 5,845,639 to Hockman et al; discloses a optical imaging method.

US 7,041,096 to Malis et al; discloses an electrosurgical generator apparatus.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ADAM J. EISEMAN whose telephone number is (571)270-3818. The examiner can normally be reached on Monday-Friday 9:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AE  
7/17/2010  
/A. J. E./  
Examiner, Art Unit 3736

/Max Hindenburg/  
Supervisory Patent Examiner, Art Unit 3736